

REMARKS

Claims 1-4, 6-19 and 21-32 were pending as of the action mailed on April 5, 2007.

Claims 1, 9, 10, 13, 16, 24, 25 and 28 have been amended. No claims have been cancelled. Claims 33-44 have been newly added. No new matter has been added. Support for the amendments to claims 1, 10, 13, 16, 25 and 28 may be found in the applicant's specification at least at page 9, line 24 through page 10, line 10. Support for the amendments to claims 9 and 24 may also be found in the applicant's specification at least at page 9, lines 11-23. Newly added claims 33-37 are system claims corresponding to method claims 1-4 and 9, and product claims 16-19 and 24. Support for newly added claims 38-44 may be found within the applicant's specification at least at page 10, lines 3-7.

Reexamination and reconsideration of the action are requested in light of the forgoing amendments and the following remarks.

Section 102 Rejections

Claims 1-4, 6-8, 10-19, 21-23 and 25-30 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Pub. US 2004/0006744 ("Jones").

Claims 1, 10, 13, 16, 25 and 28

Claims 1, 13, 16 and 28 recite "one or more rules deduced from the structure of the structured electronic document." The passage from Jones cited by the examiner in rejecting this limitation indicates the use of "a schema [which] states what tags and attributes are used to describe content in an XML document," (Jones - paragraph #0031). The applicant submits that a schema is an "express" set of rules quite different from "implied" rules which are deduced from the structure of a document (*See* the applicant's specification, page 5, line 5 through page 6, line 4). Thus, though Jones teaches an express set of rules found within a schema, Jones does not in fact teach implied rules "deduced from the structure of the structured electronic document," as recited in claims 1, 13, 16 and 28.

Regarding claims 1, 10, 13, 16, 25 and 28, the applicant respectfully submits that rejections under 35 U.S.C. § 102(e), specifically require that the “invention was described in an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.”

More specifically, “Under 35 U.S.C. § 102, anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851, 105 S. Ct. 172 (1984). In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964).” *Akzo N.V. v. U.S. Intern. Trade Comm'n*, 808 F.2d 1471, 1479 (Fed. Cir. 1986) (emphasis added).

Claims 1, 10, 13, 16, 25 and 28 recite “suggesting one or more changes to a user which would correct the identified structured aspect.” The passage from Jones cited by the examiner in rejecting this limitation merely indicates that “error data may also include further information related to the error, such as suggestions about how to possibly rectify the error which may be displayed to the user,” (Jones - paragraph #0034). Thus, the applicant submits that though Jones teaches suggestions to the user on how to rectify the error, Jones does not in any way teach how this process is accomplished, and therefore, Jones is not enabling as to that limitation.

Finally, to expedite prosecution, and without prejudice, claims 1, 10, 13, 16, 25 and 28 have been amended to recite features not found within Jones. Specifically, the claims have been amended to recite presenting the user with a predetermined suggestion template corresponding to a specific validation error. The applicant respectfully submits that nothing in Jones discloses a predetermined suggestion template corresponding to a specific validation error, as recited in the applicant's amended claims.

Remaining Claims

The remaining claims depend from or correspond to independent claims 1, 10, 13, 16, 25 and 28, and are allowable for at least those reasons that apply to those independent claims.

Withdrawal of the rejection under 35 U.S.C. § 102(e) is therefore respectfully requested.

Section 103 Rejections

Claims 9, 24, 31 and 32 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jones in view of by U.S. Patent Pub. US 2004/0268304 ("Kuo").

Claims 9 and 24

Claims 9 and 24 respectively depend from or correspond to independent claims 1 and 16, and are allowable for at least those reasons that apply to those independent claims. Additionally, claims 9 and 24 have been amended to recite features not found within the combined teachings of Jones and Kuo. Specifically, claims 9 and 24 have been amended to recite that predefined user preferences as including ranking particular changes higher than other changes.

Remaining Claims 31 and 32

Claims 31 and 32 respectively depend from or correspond to independent claims 10 and 25, and are allowable for at least those reasons that apply to those independent claims.

Withdrawal of the rejection under 35 U.S.C. § 103(a) is therefore respectfully requested.

New Claims 33-44

Support for the newly added claims is noted above.

Conclusion

By responding in the foregoing remarks only to particular positions taken by the examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, the applicant's decision to amend or cancel any claim should not be

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understood as implying that the applicant agrees with any positions taken by the examiner with respect to that claim or other claims.

The one (1) additional independent claim in the amount of \$200 and eleven (11) additional dependent claims in the amount of \$550 are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply all charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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